

*Westlaw*

1998 WL 1736155 (Bd.Pat.App & Interf.)  
(Cite as: 1998 WL 1736155 (Bd.Pat.App & Interf.))



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Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)  
EX PARTE HERVY A. MORRIS  
Appeal No. 98-2109  
Application No. 08/500,315 [FN1]

NO DATE REFERENCE AVAILABLE FOR THIS DOCUMENT

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Before CALVERT, NASE, and CRAWFORD

Administrative Patent Judges

CALVERT

Administrative Patent Judge

ON BRIEF

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 3, 5 and 9 to 11, the examiner having indicated in the answer that, as to the other claims remaining in the application, claims 21 to 24 are allowed, and claims 4, 20 and 25 would be allowable if rewritten in independent form.

The subject matter in issue is exemplified by claim 1, the only independent claim on appeal, which reads (emphasis added):

A liquid-jet cutting device comprising:

a cutting element for emitting a liquid-jet stream to cut a product located upon a product support surface;

an assembly for moving the cutting element between a cutting position located a cutting distance, within a cutting range, from the product and an idle position located an idle distance from the product support surface; and

a deflector disk, located proximate the idle position of the cutting element, to deflect the liquid-jet stream when the cutting element is moved to the idle position.

The reference applied in the final rejection is:

Driver 5,318,395 Jun. 7, 1994

Claims 1 to 3, 5 and 9 to 11 stand finally rejected as being anticipated by Driver, under 35 U.S.C. § 102(b).

We note initially that on page 11 of the brief, appellant argues that Driver is nonanalogous art. This argument will be given no consideration, because it is well settled that "the question whether a reference is analogous art is irrelevant to whether that reference anticipates." In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

The basis of the rejection is set forth on pages 3 and 4 of the final rejection (Paper No. 11).

Appellant argues that Driver does not anticipate claim 1 because there is no disclosure of the two limitations underlined in the copy of the claim, *supra*. With regard to the first of these limitations, i.e., the recitation "to cut a product located upon a product support surface," the examiner argued in the final rejection (page 7) that Driver meets this limitation because the pipeline 30 supports the product (liner) 35 to be cut. Appellant, on the other hand, asserts that this limitation must be interpreted "to be a surface which supports the product around where it is being cut," otherwise the limitation is superfluous (brief, page 7).

It is fundamental that during the examination of an application, the pending claims must be interpreted as broadly as their terms reasonably allow, and that limitations appearing in the specification may not be read into the claims. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Here, all that claim 1 specifies is that the product is "located upon a product support surface," and does not require that the product be supported at the point where it is being cut. Driver's liner 35, the product being cut, is located upon the surface of pipe 30 which supports it; therefore, interpreting the limitation in question as broadly as reasonable, it is met by Driver, even though Driver's liner 35 is not supported (i.e., backed up) by pipe 30 at the point where it is being cut by the liquid from nozzle 604. If this limitation is superfluous, as argued by appellant, that is simply an indication of its breadth.

\*2 Turning to the second limitation in dispute, the examiner argues (answer, pages 5 and 6):

[t]he phrase "to deflect the liquid-jet stream ...." should not be construed as defining structure. It does not describe any structure; it merely expresses what the disk is desired to do. However, it has well been established that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, [370 F.2d 576, 580,] 152 USPQ 235[ [, 238] (CCPA 1967); In re Otto, [312 F.2d 937, 940,] 136 USPQ 458, 459 (CCPA 1963). Therefore, it is irrelevant whether Driver's disk deflects fluid when the cutting element is moved to the idle position. However under certain conditions such as when Driver's device is inserted in a pipe section that already has been ported, Driver's disk will certainly deflect fluid when the cutter is moved to the idle position as there is no liner material between the cutting element and the disk to hinder the stream of fluid from hitting the disk.

Although we appreciate the examiner's position, we do not agree with his argument, because in our view the disk 620 of Driver is not capable of performing the intended use recited, i.e., of "deflect[ing] the liquid-jet stream when the cutting element is moved to the idle position." While the disk 620 is located

"proximate the idle position" of cutting-element (nozzle) 604, as claimed, it cannot perform the function of deflecting the jet from the nozzle 604 when the nozzle is in the idle position (Fig. 7), because, since nozzle 604 does not emit a jet when it is in that position there is no jet to be deflected; as disclosed by Driver at col. 5, lines 27 to 36 (see also claim 5), supplying fluid to cutter 600 will cause the nozzle 604 to move outward (from the Fig. 7 idle position) and contact the inside wall of the liner (Fig. 8). The examiner's statement in the last sentence of the above-quoted argument is not understood, since a stream of fluid is not emitted from Driver's nozzle 604 when it is in the idle position.

Our conclusion that claim 1 is not readable on the Driver apparatus is not contrary to the Otto or Casey decisions cited by the examiner. [FN2] Unlike those cases, the present limitation does not constitute "a method concept" which may not be relied on to distinguish a structural claim over the prior art (Otto, id.), or a manner or method of using the claimed machine "which is not germane to the issue of patentability of the machine itself" (Casey, id.). Rather, the limitation is in the nature of a structural limitation, in that it effectively requires a cutting element which is capable of emitting a liquid-jet stream when in the idle position; otherwise, there would be no stream for the disk to deflect. Driver does not disclose a cutting element which can operate in such a manner, and therefore does not anticipate claim 1. We note in this regard that "[t]here is nothing intrinsically wrong in defining something by what is does rather than by what it is." In re Echerd, 471, F.2d 632, 635, 176 USPQ 321, 322 (CCPA 1973).

\*3 Accordingly, the rejection of claim 1, and therefore of claims 2, 3, 5 and 9 to 11 dependent thereon, will not be sustained.

#### Conclusion

The examiner's decision to reject claims 1 to 3, 5 and 9 to 11 is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

BOARD OF PATENT APPEALS AND INTERFERENCES

IAN A. CALVERT

Administrative Patent Judge

JEFFREY V. NASE

Administrative Patent Judge

MURRIEL E. CRAWFORD

Administrative Patent Judge

FN1. Application for patent filed July 10, 1995.

FN2. See also In re Schreiber, 128 F.3d at 1477, 44 USPQ2d at 1431 ("the recitation of a new intended use for an old product does not make a claim to that old product patentable").

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